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OFFICE OF PETITIONS

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In re Patent of Du et al.	:	DECISION ON REQUEST
Patent No. 7,895,123	:	FOR RECONSIDERATION OF
Issue Date: February 22, 2011	:	PATENT TERM ADJUSTMENT
Application No. 09/879,267	:	AND NOTICE OF INTENT TO
Filing Date: June 12, 2001	:	ISSUE CERTIFICATE OF
Attorney Docket No. 12587-0015001	:	CORRECTION

This is a decision on the "Application for Patent Term Adjustment Under 37 C.F.R. § 1.705(d)" filed April 13, 2011, which is being treated as a petition under 37 C.F.R. § 1.705(d) requesting the patent term adjustment indicated on the patent be corrected to indicate the term of the patent is extended or adjusted by eight hundred eighteen (818) days.

The petition to correct the patent term adjustment indicated on the patent to indicate the term of the patent is extended or adjusted by eight hundred eighteen (818) days is **GRANTED to the extent indicated herein.**

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 C.F.R. § 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, Patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 C.F.R. § 1.136.

No portion of this decision should be construed as a waiver of the requirement, set forth in 35 U.S.C. § 154(b)(4), that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. § 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Delay Under 35 U.S.C. § 154(b)(1)(A) ("A Delay")

The period of A Delay is 623 days and is not in dispute.

Delay Under 35 U.S.C. § 154(b)(1)(B) ("B Delay")

The petition asserts the period of B Delay is 408 days, not 276 days as previously calculated by the Office.

Pursuant to 35 U.S.C. § 1.154(b)(1)(B)(i), the period of B Delay does not include “any time consumed by continued examination of the application.”

The petition argues the “time consumed by continued examination of the application” does not include the period of time beginning October 14, 2010, the date the Office issued a Notice of Allowance, and ending on February 22, 2011, the date the Office issued the patent.

“Once a request for continued examination ... is filed in an application, any further processing or examination of the application, including granting of a patent, is by virtue of the continued examination given to the application under 35 U.S.C. 132(b).”¹ In other words, the time period consumed by continued examination of the application ends on the date a patent is issued, *not* the day before the date a Notice of Allowance is issued.

The application was filed June 12, 2001. The first request for continued examination (“RCE”) filed in this case was filed on March 16, 2005. The patent issued February 22, 2011.

37 C.F.R. § 1.703(b)(1) states,

The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

- (1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

The number of days beginning June 13, 2004, the day after the date three years after the filing date, and ending February 22, 2011, the date the patent issued, is 2,446 days, and the number of days beginning March 15, 2005, the date the first RCE was filed, and ending February 22, 2011, the date the patent issued, is 2,170 days. Therefore, the period of B Delay is 276 (2,446 - 2,170) days.

Delay Under 35 U.S.C. § 154(b)(2)(C) (“Applicant Delay”)

The petition states the total period of Applicant Delay is 213 days, not 165 days as previously calculated by the Office.

Issue 1 Involving the Period of Applicant Delay

The Office issued a Notice to File Corrected Application Papers on August 15, 2001. A reply to the notice was filed December 4, 2001.

¹ Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56365, 56376 (September 18, 2000) (response to comment 8)

The petition states the period of Applicant Delay should include a 19-day period for delay in the submission of a reply to the August 15, 2001 notice.

37 C.F.R. § 1.704(b) provides for a reduction when a party takes more than 3 months to respond to any notice or action by the Office making any rejection, objection, argument or other request. Specifically, 37 C.F.R. § 1.704(b) states,

[A]n applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed.

The number of days beginning November 16, 2001, the day after the date the Office issued the notice, and ending December 4, 2001, the date a reply was filed, is 19 days. Therefore, the Office agrees the period of Applicant Delay should include a 19-day period for delay in the submission of a reply to the August 15, 2001 notice.

Issue 2 Involving the Period of Applicant Delay

Patentees filed a reply to a final Office action on February 10, 2006. Patentees subsequently filed an information disclosure statement ("IDS") on March 6, 2006. The record does not indicate the examiner expressly requested submission of the IDS, and the IDS was not filed with a statement under 37 C.F.R. § 1.704(d).

The petition asserts the period of Applicant Delay should include a 24-day period based on the submission of the March 6, 2006 IDS.

Per 37 C.F.R. § 1.704(c)(8), circumstances that will result in a reduction in the period of adjustment include:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

The number of days beginning February 11, 2006, the day after the date the reply was filed, and ending March 6, 2006, the date the IDS was submitted, is 24 days. Therefore, the Office agrees the period of Applicant Delay should include a 24-day period based on the submission of the IDS on March 6, 2006.

Issue 3 Involving the Period of Applicant Delay

The Office issued the Notice of Allowance on October 14, 2010. Patentees filed a Request for Corrected Filing Receipt on January 10, 2011. The Office issued a corrected filing receipt on January 14, 2011.

The petition asserts the period of Applicant Delay should include a 5-day period based on the submission of the Request for Corrected Filing Receipt.

37 C.F.R. § 1.704(c)(10) states,

[Upon] [s]ubmission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed ... the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
- (ii) Four months.

The number of days beginning January 10, 2011, the date the Request for Corrected Filing Receipt was filed, and ending January 14, 2011, the date the Office issued a response to the request, is 5 days. Therefore, the Office agrees the period of Applicant Delay should include a 5-day period based on the submission of the Request for Corrected Filing Receipt.

Issue 4 Involving the Period of Applicant Delay

A review of the record indicates the period of Applicant Delay should include a 28-day period for delay based on the submission of a petition under 37 C.F.R. § 1.137(f) after the issuance of the Notice of Allowance.

The Office issued the Notice of Allowance on October 14, 2010. Patentees filed the petition under 37 C.F.R. § 1.137(f) on October 27, 2010. The Office issued a decision granting the petition on November 23, 2010.

Since the petition under 37 C.F.R. § 137(f) petition was filed after issuance of the Notice of Allowance, a reduction in patent term adjustment is warranted under 37 C.F.R. § 1.704(c)(10). The number of days beginning October 27, 2010, the filing date of the petition under 37 C.F.R. § 1.137(f), and ending November 23, 2010, the date the Office issued a decision on the petition, is 28 days. Therefore, the period of Applicant Delay should include a 28-day period for delay under 37 C.F.R. § 1.704(c)(10) resulting from the submission of the October 27, 2010 petition.

The Total Period of Applicant Delay

The correct period of Applicant Delay is 241 days, which is the 165 days originally calculated by the Office increased by the 19-day, 24-day, 5-day, and 28-day periods of delay previously discussed.

The Correct Patent Term Adjustment

The period of A Delay is 623 days.

The period of B Delay is 276 days.

The total period of Applicant Delay is 241 days.

The correct patent term adjustment is 658 days, which is the sum of 623 days of A Delay and 276 days of B Delay reduced by 241 days of Applicant Delay.

The Office acknowledges submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the patent is extended or adjusted by **six hundred fifty-eight (658) days**.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION**

PATENT NO. : 7,895,123 B1
APPLICATION NO. : 09/879,267
DATED : February 22, 2011
INVENTOR(S) : L. Garren Du et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the Title page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 734 days.

Delete the phrase "by 734 days" and insert -- by 658 days--